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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : David Allison Bennett, et al.
Application No. : 09/684,871
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING SHIPPING LOCATION COMPARISON ACROSS MULTIPLE CARRIERS
Technology Ctr : 3600
Grp./Div. : 3629
Examiner : Jamisue A. Plucinski
Docket No. : PSTM0003/MRK

APPELLANT'S REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
June 30, 2008

Commissioner:

Enclosed are the following:

1. Appellant's Reply Brief (10 pages); and
2. Return post card.

It is respectfully submitted that the enclosed Appellant's Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of June 30, 2008, which is the last day of the two month period following the May 1, 2008 date of the Examiner's Answer.

Even so, the Commissioner is hereby authorized, pursuant to 37 CFR 1.136(a)(3), to treat any concurrent or future reply or correspondence for the above-identified application, requiring a petition for an extension of time for its timely submission, as incorporating a constructive petition for extension of time for the appropriate length of time. The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17, including any required extension fees, which may be required during the **pendency** of this application, to Deposit Account No. 501574.

Appellant's Reply Brief Transmittal
Application Serial No. 09/684,871

Please show our docket number with any charge or credit to our Deposit Account. **A copy of this letter is enclosed.**

Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By



Marilyn R. Khorsandi
Reg. No. 45,744
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MRK/aa
Enclosures

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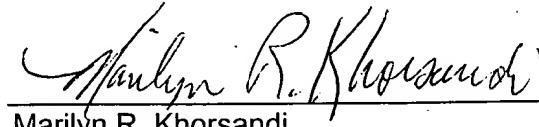
Appellant's Reply Brief Transmittal
Application Serial No. 09/684,871

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PATENT

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APPLICANTS' REPLY BRIEF

This is a Reply to the Examiner's Answer, dated May 1, 2008, regarding the pending Appeal of the rejection of Claims 1-10 and 15-21 in the case of the above-identified application.

An Oral Hearing is not requested.

It is respectfully submitted that this Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of July 1, 2008, which is the last day of the two month period following the May 1, 2008 date of the Examiner's Answer.

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REPLY ARGUMENT

ISSUE 1A REPLY ARGUMENT REGARDING THE REJECTION OF INDEPENDENT CLAIMS 1, 2, 3, 8, 9, 10, 15, 16 AND 17, AND DEPENDENT CLAIMS 4-7 AND 18-21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF INTERSHIPPER

Under the Issue 1a Argument heading, the Appeal Brief presented with specificity and under cited legal authority, a foundation for proper construction and interpretation of the claimed terms “shipping location,” “default shipping location,” and “determine ... according to shipping location rules for the carrier.” Based on the respectfully asserted proper construction of those terms, the Appeal Brief then explained under subsequent Issue headings, distinctions between the claimed terms and the disclosures of Nicholls and Kara as those references are asserted by the Office Action appealed and by the Examiner’s Answer.

Even so, the Examiner’s Answer states that “... appellant has failed to argue how the references as applied, are different to the claimed invention and has failed to argue ‘how’ the prior art of record does not disclose these terms.” Examiner’s Answer, Topic (10) Response to Argument, p. 5.

It is respectfully submitted that, contrary to the above-noted assertion by the Examiner’s Answer, the Appeal Brief presented numerous distinctions between the claimed invention and the cited references. See, e.g., Appeal Brief, Argument regarding Issue 1b, pgs. 21-27 (asserting, for example at p. 23, ¶2 that “...when read together with other disclosures of Nicholls, the disclosed Nicholls system does not make any determination or identification of each carrier’s support for shipping a particular parcel from a particular shipping location according to the respective carrier’s shipping location rules, which is claimed, in one way or another, by the Claims on Appeal. Rather, it is respectfully asserted that the above-quoted disclosure of Nicholls, when read together with other disclosures of Nicholls, is evidence that, at most, Nicholls is preprogrammed to observe carrier-specific shipping location rules for a user for which a Nicholls system is installed.”).

The Examiner's Answer disagrees with the distinctions under subsequent Issue headings (See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 7, ¶2), but in doing so, fails to consider the asserted claim construction presented under the Appeal Brief's Issue 1a Argument heading, or offer any grounds why the claim construction asserted by the Appeal Brief under that heading should not stand. See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 5 – 6, ¶1. Rather, the Examiner's Answer asserts its own definitions of the claimed terms but fails to cite support for those definitions from the Specification. In particular, rather than interpreting the claimed limitations in view of the Specification of the present application as prescribed under relevant legal authority (see, e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), aff'd, 517 U.S. 370 (1996)), it is respectfully asserted that the Examiner's Answer improperly interprets the claimed limitations in view of a reading of the cited references influenced by the disclosure of the present application. See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 5 – 6, ¶1. It is respectfully asserted that the definitions asserted by the Examiner's Answer are therefore not a supportable construction of the claimed terms in view of standard claim construction rules.

It is respectfully asserted therefore, that the disagreement by the Examiner's Answer with the distinctions made by the Appeal Brief under subsequent Appeal Brief headings between the properly constructed claimed terms on the one hand, and the disclosures of Nicholls and Kara on the other hand, is wrong and stands unsupported.

ISSUE 1B REPLY ARGUMENT REGARDING THE REJECTION OF INDEPENDENT CLAIMS 1, 2, 3, 8, 9, 10, 15, 16 AND 17, AND DEPENDENT CLAIMS 4-7 AND 18-21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF INTERSHIPPER

For the reasons given above, it is respectfully asserted that the disagreement by the Examiner's Answer with the distinctions made by the Appeal Brief under the Issue 1b heading fails to consider the asserted claim construction presented under the Appeal Brief's Issue 1a Argument heading, or offer any grounds why the claim construction

asserted by the Appeal Brief under that heading should not stand. See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 6, ¶1.

Moreover, it is respectfully asserted that the Examiner's Answer proffers definitions of claimed terms such as, for example, "shipping location," that are wrong because they are inconsistent with the Specification of the present application. Cf., e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), aff'd, 517 U.S. 370 (1996). Then, based on the improperly proffered definitions, the Examiner's Answer asserts that the claims are obvious in view of the cited references.

For example, the Examiner's Answer urges that "[i]n order for a shipping rate to be determined, the starting point (origin) and the ending point (destination) must be known." Examiner's Answer, Topic (10) Response to Argument, p. 6, ¶2. The Examiner's Answer further asserts that "Nicholls and Kara discloses [sic] the use of zones for the calculation, which the examiner considers to be the form of a shipping location" Examiner's Answer, Topic (10) Response to Argument, p. 6, ¶2.

For the reasons given in the Appeal Brief, and for the reasons given above, it is respectfully asserted that the above-outlined position urged by the Examiner's Answer is wrong because it is inconsistent with the Specification of the present application and therefore improperly interprets the claimed terms. In particular, it is respectfully asserted that in order to ascertain the meaning of the terms "shipping location," "default shipping location," and "determine ... according to [a carrier's] shipping location rules" as those terms are used in the Claims, it is proper to consider the Specification of the present patent application. See, e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), aff'd, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." (citations omitted)). It is respectfully asserted that the Appeal Brief provided properly supported interpretations of the claimed limitations (see, e.g., Appeal Brief, Issue 1a Argument, pgs. 19-21), and explained distinctions between the properly constructed claimed terms and the cited references. See, e.g., Appeal Brief, Argument regarding Issue 1b, pgs. 21-27.

Further still, the Examiner's Answer states that “[t]he claims as well as the specification, allow for the user to ship from the user's address, therefore Nicholls and Kara teach the 'claimed' invention of the shipping location.” Examiner's Answer, Topic (10) Response to Argument, p. 7, ¶¶2.

It is respectfully asserted that the above-stated position by the Examiner's Answer urges an incorrect interpretation of the claim language, because it is inconsistent with the Specification of the present application and is further inconsistent with the language of the Claims.

In particular, there is no dispute that, as the Examiner's Answer urges, a user may wish to ship from the user's address. However, it is respectfully submitted that the Claims are not directed to whether or not a user may or may not choose to ship from the user's address. Rather, the Claims are directed to systems and methods for determining *which carriers of a plurality of carriers* would support shipping a particular parcel from the user's indicated shipping location. That is, assuming for the sake of an example, that a user wishes to ship from the user's own address, it is respectfully asserted that the Claims are directed to systems and methods for determining which carriers of a plurality of carriers would support shipping from the user's own address.

In support of the above-mentioned claimed subject matter, the Specification explains that although some carriers may support shipping from a particular address, such as a user's address, others may not. See, e.g., Specification, p. 2, lines 21-22 (“...Carrier pickup and drop-off shipping location rules can differ by city, state, and zip code and to some extent, parcel specifications for the parcel to be shipped.”); see also, e.g., Specification, p. 2, lines 23-25 (explaining that in order to identify whether a particular Carrier would ship a particular parcel from a particular shipping location, a “...Shipper must determine each Carrier's pickup and drop-off shipping location rules for the Shipper's own physical location as applied to the particular parcel to be shipped.... each Carrier's shipment pricing may differ according to shipping location.”).

Not only may some carriers not support shipping from a particular address, but the Specification further explains that “... each Carrier's shipment pricing may differ according to shipping location. Specification, p. 2, line 25; see also, e.g., Specification, p. 63, lines 11-20 (explaining with respect to an exemplary embodiment, that “...the

System then determines whether the Shipper has requested a "Call for Pickup" shipping location If so, the System accesses the Carrier Database ... to determine whether the particular Carrier/Service supports "Call for Pickup" services ... If the particular Carrier/Service does not support "Call for Pickup" services, [t]hen the particular Carrier/Service is eliminated from the delivery rate set ... and the System proceeds with the next Carrier/Service in the delivery rate set ... If the particular Carrier/Service supports "Call for Pickup" services, the System adds the appropriate charge for the "Call for Pickup" service to each of the particular Carrier/Service's delivery rates").

For the reasons given in the Appeal Brief and for the reasons given above, it is respectfully asserted that there is no mention in any of the references or record of any distinction between Carriers and/or Services as to differences in support, and/or rates, for different shipping locations, including different shipping locations that may exist within a single zone.

For the reasons given and the authorities cited in the Appeal Brief, and for the reasons given above, it is therefore respectfully asserted that the disagreement by the Examiner's Answer with the distinctions made by the Appeal Brief under the Issue 1b heading between the properly constructed claimed terms on the one hand, and the disclosures of Nicholls and Kara on the other hand, stands unsupported.

For the above-given reasons, and for the reasons given and authorities cited in the Appeal Brief, in view of the previously-described and above-described distinctions between the disclosures of Nicholls, Kara and InterShipper on the one hand, and independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, namely, dependent Claims 4-7 and 18-21, on the other hand, it is therefore respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed and that those Claims be allowed.

Issue 2 Reply Argument Regarding the Rejection of Independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and Dependent Claims 4-7 and 18-21 Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Kara in further view of InterShipper

The Examiner's Answer states that "... appellant is arguing that 'every method' means each delivery service offered by each carrier." Examiner's Answer, Topic (10) Response to Argument, p. 7, ¶3. It is respectfully asserted that the aforementioned statement by the Examiner's Answer misconstrues and misstates the Appeal Brief argument.

In particular, the Appeal Brief under the Issue 2 heading argued that independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17 claim, in one way or another, generating a simultaneous online display of, or comprising an identification of, a plurality of delivery services for each carrier of a plurality of carriers.

The Appeal Brief asserted that InterShipper does not state that its display comprises a display of rates for each delivery service offered by each carrier but rather states only that the "[t]he free service will return every method possible that you can use to ship your package . . ." InterShipper, p. 1, ¶ 2. It was therefore respectfully asserted that InterShipper's reference to "every method" may have referred to a plurality of carriers rather than to a simultaneous online display of, or comprising an identification of, a plurality of delivery services for each carrier of a plurality of carriers as claimed in one way or another by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17.

Notably, the Examiner's Answer concedes that InterShipper "is not completely clear" that the term "every method" means each delivery service for each carrier. Examiner's Answer, Topic (10) Response to Argument, p. 7, ¶3. However, the Examiner's Answer asserts that InterShipper is combined with Kara. *Id.*

Notwithstanding the combination asserted by the Office Action and the Examiner's Answer of InterShipper with Kara, both the Office Action and the Examiner's Answer concede that Kara only discloses a display of rates for each carrier for a particular [pre-selected] delivery service (See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 8, ¶1; Office Action, Topic No. 5, p. 4), and further concede that "Kara and Nicholls ... fails to disclose the simultaneous display of the rates for each

carrier for each service." Examiner's Answer, Topic No. 6, p. 5; Office Action, Topic No. 6, p. 4.

In view of the above-identified concessions by the Examiner's Answer, it is therefore respectfully asserted that there is a complete absence of any disclosure by any of the references of record of a simultaneous display or identification as claimed in one way or another by independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17. It is therefore respectfully asserted that independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17 are distinguished from, and patentable over, the references of record, even when those references are considered in combination.

For the above-given reasons, and for the reasons given and authorities cited in the Appeal Brief, in view of the previously described, and above-described, distinctions between the disclosures of Nicholls, Kara and InterShipper on the one hand, and independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, namely, dependent Claims 4-7 and 18-21, it is therefore respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed and that those Claims be allowed.

ISSUE 2A REPLY ARGUMENT REGARDING THE REJECTION OF DEPENDENT CLAIMS 7 AND 21 UNDER 35 U.S.C. §103(A) AS UNPATENTABLE OVER NICHOLLS IN VIEW OF KARA IN FURTHER VIEW OF INTERSHIPPER

It is respectfully asserted that the disagreement by the Examiner's Answer with the distinctions made by the Appeal Brief under the Issue 2a heading fails to consider the asserted claim construction presented under the Appeal Brief's Issue 1a Argument heading, or offer any grounds why the claim construction asserted by the Appeal Brief under that heading should not stand. See, e.g., Examiner's Answer, Topic (10) Response to Argument, p. 8, ¶2.

Moreover, it is respectfully asserted that the Examiner's Answer proffers incorrect definitions of claimed terms such as, for example, "shipping location." For the reasons given and authorities cited previously above, it is respectfully asserted that the definitions proffered by the Examiner's Answer are wrong because they are inconsistent with the Specification of the present application. Then, based on the incorrectly

constructed proffered definitions, the Examiner's Answer asserts that Claims 7 and 21 are obvious in view of the cited references.

For the reasons given and the authorities cited in the Appeal Brief, and for the reasons given and authorities cited above, it is therefore respectfully asserted that the disagreement by the Examiner's Answer with the distinctions made by the Appeal Brief under the Issue 2a heading between the properly constructed claimed terms on the one hand, and the disclosures of Nicholls and Kara on the other hand, stands unsupported.

For the reasons given and the authorities cited in the Appeal Brief, and for the reasons given above, it is therefore respectfully requested, in view of the above-described and previously described distinctions between the disclosures of Nicholls, Kara and InterShipper on the one hand, and dependent Claims 7 and 21 on the other hand, that the rejection of Claims 7 and 21 be reversed and that those Claims be allowed.

REPLY ARGUMENT CONCLUSION

For the foregoing reasons, and for the reasons given and the authorities cited in the Appeal Brief, it is respectfully asserted that none of Nicholls, Kara, or InterShipper, whether considered alone or in combination with any other reference(s) of record, anticipate, disclose, teach or suggest all of the limitations of independent Claims 1, 2, 3, 8, 9, 10, 15, 16 and 17, and therefore the Claims dependent on them, namely, dependent Claims 4-7 and 18-21, of the present application. It is therefore respectfully requested that the rejection of Claims 1-10 and 15-21 be reversed and that those Claims be allowed.

Respectfully submitted,

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